

REMARKS / ARGUMENTS

This application is believed to be in condition for allowance because the claims are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Premature Final Rejection:

As explained in M.P.E.P. 706.07(d), "If, on request by applicant for reconsideration, the primary examiner finds the ***final rejection to have been premature, he or she should withdraw the finality of the rejection***. The finality of the Office action ***must*** be withdrawn while the application is still pending." (emphasis added)

M.P.E.P. 706.07(a) explains that "second or any subsequent actions on the merits shall be final, ***except where the examiner introduces a new ground of rejection*** that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..." (emphasis added).

The examiner ***has*** introduced new grounds of rejection. In particular, in the current action, the Office Action rejected claim 1 by stating, in part:

"Smiga teaches... parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person (*Fig. 2, element 300, parser col. 5, line 63 - col. 6, line 13, col. 23, lines 17-23, please note the claimed electronic documents including any of ... textual data, Smiga teaches parsing text data*)."

However, in the prior action, dated October 22, 2004, the Office Action rejected claim 1 by stating, in part:

“Smiga teaches... parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person (*Smiga*, col. 5, line 63 - col. 6, line 13, *the parser of Smiga parses document, and identifies email addresses enclosed in the document, the email address identifies a person*).”

Specifically, in the current action, the Office Action is suggesting that the “**parser**” described by **Smiga** in Fig. 2, element 300, parser col. 5, line 63 - col. 6, line 13, col. 23, lines 17-23 teaches the claimed element of “parsing an electronic document... to identify data representing any person.” However, in the previous action, the Office Action suggested that the claimed element of “parsing an electronic document... to identify data representing any person” was taught by the **Smiga** reference with respect to an alleged capability of **Smiga** to **identify email addresses in a document**. The Office Action offered col. 5, line 63 - col. 6, line 13 in support of that argument.

In response to the October 22, 2004 Office Action, the Applicants explained that the Office Action had incorrectly characterized the **Smiga** reference with respect to the alleged capability to extract email addresses from a document. This incorrect characterization is **not** addressed in the current action. Instead, the current Office Action simply states that Applicants arguments are not persuasive, and then provides an explanation as to why those arguments are not persuasive in light of the **new** grounds of rejection. Clearly, Applicants have not been afforded any prior opportunity to address the new grounds of rejection, and as such, the finality of those rejections is premature.

Further, it must be noted that the Applicants did **not** amend the claims in the response filed in reply to the prior Office Action. Consequently, the new grounds of

rejection advanced by the current Office Action are **not** necessitated by any amendment of the claims.

Therefore, because the current Office Action provides new grounds of rejection in rejecting the claims, in accordance with M.P.E.P. 706.07, the finality of the prior Office Action must be withdrawn as being premature. Thus, Applicants respectfully request immediate withdrawal of the finality of the rejections advanced in the current Office Action, and further examination and reconsideration of the claimed invention.

2.0 Rejections under 35 U.S.C. §103(a):

In the Office Action of May 20, 2005, claims 1, 4-6, 9, 11, 13, 14, 20, 24-27, 29, 35-38, 40, 41 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smiga et al. ("**Smiga**," US Patent 6,421,678) in view of Thorner et al. ("**Thorner**," US Patent 6,463,443).

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Smiga** in view of **Thorner**, and in further view of Srinivasan ("**Srinivasan**," US Patent 6,717,936).

Claims 7, 8 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smiga** in view of **Thorner**, and in further view of Dimitrova ("**Dimitrova**," US Patent 6,363,380).

Claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smiga** in view of **Thorner**, and in further view of Sorenson ("**Sorenson**," US Patent 6,628,729).

Claims 15, 28, 30 and 42-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smiga** in view of **Thorner**, and in further view of Yamakita ("**Yamakita**," US Patent 6,272,490).

Finally, Claims 16-19, 21-23, 31-34, and 46-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smiga** in view of **Thorner**, and in further view of Appelman et al. ("**Appelman**," U.S. Patent 6,539,421).

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, **there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify the reference or to combine reference teachings**. Second, there must be a **reasonable expectation of success**. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), **all** of the claimed elements of an Applicant's invention must be considered, **especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists**. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1 Rejection of Claims 1, 4-6, 9, 11, 13, 14, 20:

Independent claim 1 was rejected under 35 U.S.C. §103(a) based on the rationale that **Smiga** discloses several elements of the Applicant's claimed system for automatically alerting a user to available information, with the remainder of the claimed elements being disclosed by **Thorner**.

In particular, the Office Action first suggests that **Smiga** discloses “parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person; identifying at least one person represented by the identified data.” The Office Action offers Fig. 2, element 300, parser col. 5, line 63 - col. 6, line 13, and col. 23, lines 17-23 of the **Smiga** reference in support of this contention by suggesting that “**the claimed electronic documents** including any of ... textual data, **Smiga teaches parsing text data**” (emphasis added).

Further, in response to the Applicants prior arguments, the Office Action suggests that **Smiga** “teaches parsing **user input text data** ...” and that this user input (typed as a direct user entry via the keyboard) is the same as the Applicants claimed “**electronic documents**... including... textual ... data.” (emphasis added). The Office Action cites **Smiga**, “Fig. 2, element 300, parser col. 5, line 63 - col. 6, line 13, col. 23, lines 17-23” in support of this argument. The Office Action then concludes by stating that “The parser of Smiga has the same functionality as the claimed parser.”

However, as explained previously, Applicants believe that the Office Action has incorrectly interpreted the cited portions of the **Smiga** reference. In particular, rather than parsing **documents** to “**identify data representing any person**” and “**identifying at least one person represented by the identified data**,” **Smiga** instead parses a **free text input** entered by a user to locate predefined “**keywords**” and “**data information**” (see col. 5, lines 26-38). Once the **Smiga** parser locates a “keyword” in the user entered text data, **Smiga** then determines whether that keyword is “linked to one or more related information objects” (see col. 5, lines 35-38).

Further, it should be noted that FIG. 2 of the **Smiga** reference shows the “parser” 300 connected directly to the “user interface” 200. Clearly, Smiga is not parsing electronic documents; instead, it is parsing text strings that are manually entered via the **Smiga** user interface 200. Text data that is manually entered via a user interface is **not** an “electronic document” as described and claimed by the Applicants.

In fact, the text portions of the **Smiga** reference offered by the Office Action (col. 5, line 63 - col. 6, line 13, and col. 23, lines 17-23) fully support this interpretation. In particular, the cited text generally explains that when the user types text into the user interface 200, the parser 300 will partition the manually typed text and determine whether any of that manually typed text matches a predefined "keyword." If a match to one of the predefined keywords is found by the parser 300, the parser will then **retrieve** associated information from an external source and provide that data from the external source to the user interface 200.

For example, **Smiga** explains in col. 23 lines 13-23 that if a **keywords** identified through parsing of the **user entered text** is **associated** with a name, such as the typed text "Brian" (representing a keyword linked to "Brian Smiga"), then information relating to Brian Smiga will be returned from an external database following the match to the keyword "Brian" in the user typed text input. Similarly, with respect to email addresses, if the keyword "Brian" is associated with the an email address (specified as a match to a parsed **keyword** in an external "object database" (see col. 21 line 46 to col. 22, line 18), then that email address (presumably an address for "Brian Smiga" in this case) is merely "passed back to the user interface 200 and displayed by the user interface 200 in a keynote and shadow region on display device 121" (see col. 6, lines 11-13).

In other words, it should be clear that **Smiga** is describing, in part, a system for identifying one or more **predefined keywords** by parsing user entered text, and then passing back to the user any data from **external databases** that have been previously associated with the predefined keyword located in the parsed user entered text. It should also be clear that in the system described by **Smiga**, the user input is **not** an "electronic document" as is conventionally understood by those skilled in the art. In other words, a user input typed into a form field or the like in a user interface window, as described by **Smiga** is not as electronic document as described and claimed by the Applicant.

Furthermore, in stark contrast to the system described by **Smiga**, the Applicant describes and claims a system wherein one or more persons are first **automatically**

identified by parsing an electronic document. That information derived from parsing the document is then used to retrieve related information from at least one electronic database, as described in further detail below. Note that one major difference here between the claimed invention and that of **Simga** is that **Simga** is simply parsing a document in order to find predefined "keywords," and then to return whatever information may have been associated with those keywords in some external database. Therefore, the Applicant respectfully suggests that in direct contrast to the position advanced by the Office Action, **Simga** fails to identify "at least one person represented by the identified data," since **Simga** specifically states that it is merely returning data linked to a predefined "keyword" from some external database without any idea what that keyword represents (other than a match to some external object) in response to a keyword match, as described above.

Consequently, it should be clear that the **Simga** capability to find keywords via parsing of a **user entered text input** is **not** equivalent to parsing an electronic document to identify data representing any person, as described and claimed by the Applicant. In fact, as noted above, **Simga** has no way of determining **what** the keyword represents beyond simply determining whether a predefined keyword matches an entry in some external database, with that externally linked information then being returned to the user. While that externally linked information may be an email address or the name of a person in some cases, **Smiga** does not specifically identify persons represented by the identified data as suggested by the Office Action.

Further, as previously explained by the Applicants, one clear **advantage** of the Applicants invention over the invention disclosed by **Smiga** is that, unlike **Smiga**, the Applicants do **not** require a user to manually enter a text input which is then parsed for locating and retrieving information relating to particular predefined keywords. In fact, rather than being forced to manually enter a text input, the user is simply **automatically** notified of the availability of data relating to each identified person in any of a plurality of electronic documents once that information is automatically retrieved from one or more electronic databases. This advantage is **not** appreciated by the **Smiga** reference.

In addition, Applicants would like to respond to the suggestion that “the claimed parser and the parser of *Smiga* both parse text data, and regardless whether the parser parses user entered text input or electronic documents, their outcomes are the same.” In particular, as described above, ***Smiga*** parses user entered text in an attempt to find a predefined “keyword.” In contrast, Applicants do not describe or claim any limitation that restricts the parsing of electronic documents to a search for predefined keywords. Consequently, the “outcome” of the ***Smiga*** “parser” and the parsing performed by the Applicants claimed invention is ***not*** the same.

Next, the Office Action suggests that ***Thorner*** describes the claimed elements of “retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons.”

Clearly, ***Thorner*** describes the capability to search through a plurality of databases to identify personal information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by ***Thorner***. However, when combined with the ***Simga*** reference, the proposed combination simply produces a version of the ***Simga*** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of “***parsing an electronic document***, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, ***to identify data representing any person***; and identifying at least one person represented by the identified data,” as described above, it should be clear that the proposed ***Simga - Thorner*** combination fails to teach or describe all of the elements of the Applicant’s claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re*

Fine. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 1, and thus the rejection of dependent claims 4-6, 9, 11, 13, 14, and 20 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner**, in view of the non-obviousness of claim 1, as cited below:

“A system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, ***to identify data representing any person;***

identifying at least one person represented by the identified data;
retrieving information relating to each identified person from at least one electronic database;

notifying the user that the retrieved information is available; and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons.” (emphasis added)

In addition, with respect to claims 13 and 14, Applicants have previously explained that these claims are directed towards ***changing the appearance of the parsed document***. Specifically, the Applicant believes that the Office Action incorrectly equates the Applicants parsed document to providing a ***separate display area*** from the user data entry region on a display device (i.e., **Smiga’s** “shadow region”) for displaying information retrieved in response to a keyword identification in the manually entered user text input. The separate display area comprising the “shadow region” is ***not*** the parsed electronic document itself, and described and claimed by the applicant. Therefore, **Smiga** does not disclose changing the appearance of the parsed document as disclosed and claimed by the Applicant.

In response to this argument, the Office Action suggested "Smiga teaches shadowing the keynote" and that "shadowing... is well known in the art. The Office Action then explains that that since "Smiga has the capability of **shadowing** the keynote, it could change the appearance of the identified data in the same display area or a separate display area." The Office Action also suggests that the "the claim does not limit whether the modified appearance is displayed in the same display area or a different display area."

However, col. 7 lines 3-10 of the **Smiga** reference clearly explains that "Shadow region 230 is a window that appears beneath, or alternatively adjacent to, the keynote region 220 and contains linked object information in data fields that are automatically set as a result of parsing the keynote entered into keynote region 220. Shadow 230 includes a set of icons 240 which are always visible along with keynote region 220 in the preferred embodiment. Icons 240 serve two purposes." Clearly, in contrast to the position advanced by the Office Action, this is **not** conventional "shadowing" as is known to those skilled in the art. Further, it is also **not** a modification of a display of the parsed document to provide a **separate** window that includes information linked to keywords identified in parsed text.

Finally, with respect to the suggestion by the Office Action that the "the claim does not limit whether the modified appearance is displayed in the same display area or a different display area," the Applicants respectfully suggest that the Office Action has clearly mischaracterized the claimed invention. In particular, Applicants claim that a visible alert is provided by "dynamically modifying the appearance of the electronic document." Note that this is the **same** electronic document that is parsed in claim 1. In contrast, **Smiga** provides a separate window (called a "shadow region") that is used to display information retrieved from an external source. The appearance of the text typed by the user is not changed. Consequently, there is absolutely no support for the position advanced by the Office Action with respect to this point.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims

are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above, and the nonobvious of claims 13 and 14 with respect to the claimed element regarding “dynamically modifying the appearance of the electronic document.” Therefore, the Applicant respectfully traverses the rejection of claims 13 and 14 under 35 U.S.C. §103(a) over **Simga** in view of **Thorner**, in view of the non-obviousness of claims 13 and 14.

2.2 Rejection of Claims 24-27, 29, and 36:

As with independent claim 1, independent claim 24 was rejected under 35 U.S.C. §103(a) based on the rationale that **Smiga** discloses several elements of the Applicant’s claimed process for automatically providing information on a computer display device, with the remainder of the claimed elements being disclosed by **Thorner**.

In particular, as with claim 1, the Office Action again suggests that “the parser scans/parses the display input to identify a person.” The Office Action offers Fig. 2, col. 5, line 63 - col. 6, line 13, and col. 23, lines 17-23 of the **Smiga** reference in support of this contention.

However, the described above with respect to claim 1, Applicant again respectfully suggests that the Office Action has incorrectly interpreted the cited portions of the **Smiga** reference. In particular, as noted above, **Smiga** is simply parsing manually entered text input to a text buffer (see paragraph 14 of Office Action) by a user via a user interface (element 200 of Fig. 2) in order to find predefined “keywords,” and then to return whatever information may have been associated with those keywords in some external database.

In stark contrast, while **Smiga** reads text from a text buffer (as admitted by the Office Action), Applicants are directly **directly scanning** information that is being **rendered on a computer display device**. In view of detailed description provided in the Applicant’s specification, it should be clear that this is **not** interpreted to mean that a document is first scanned and then rendered on the display device, but that the Applicant’s system is

directly scanning the information being rendered on the display device itself to identify information being rendered on that display device which represents at least one person. This embodiment is particularly useful where a document is not necessarily directly available to a computer for parsing, such as in the case where a document is viewed over a network connection (such as, for example, an Internet web page).

For example, in paragraph 68 of the Applicant's specification, the Applicant discusses one method in which information being rendered on a display device may be parsed or otherwise examined to identify information representing at least one person. In particular, in the working example discussed in paragraph 68, the Applicant explains that the claimed system ***automatically interfaces with display rendering routines of a computer system***. The display screen of a computer is rendered in response to instructions, i.e., the display input, such as, for example compiled software code, such as a typical computer program, or, interpreted page descriptions such as an HTML or similar script. Consequently, this working example essentially parses ***all information viewable by the user***, as well as ***hidden text or instructions***, such as, for example, hidden text embedded in the HTML code of an Internet web page, to find persons. Specifically, the working example is capable ***scanning the display input looking*** for known names, email addresses (using the canonical form of XXX@YYY.ZZZ), phone numbers, etc., or any data that may represent a person, as described above.

Smiga appears to offer no such capability, as it appears to read the user typed text input into some sort of text buffer or the like which is then rendered to the display device. In fact, ***Smiga*** describes the feature through the reference as "a user input device for receiving an input text expression." Clearly, ***Smiga*** fails completely to describe, or in any way teach or suggest any system which interfaces with display rendering routines for directly "scanning electronic data ***being rendered on the computer display device***," as described and claimed by the Applicant.

Further, it should also be noted that the Office Action suggests that ***Smiga*** teaches that data in a text buffer is provided as an input that is somehow displayed on a display

device. In particular, the Office Action states that "The text buffer is connected to a display device for displaying the text." Unfortunately, this statement by the Office Action is in error. Specifically, Applicants are unaware of any way in which a text buffer can be directly connected to a display device for displaying the content of that text buffer. It is the Applicants understanding that any text in a text buffer **must** first be read into some sort of display rendering routines and/or hardware which itself interfaces with the display device. Clearly, scanning data being rendered on a display device (as disclosed and claimed by the Applicants) is not the same as parsing data in a text buffer that is then later sent to a display device (as disclosed by Smiga).

Consequently, it should be clear that parsing the contents of a text buffer is **not** equivalent to directly "scanning electronic data being rendered on the computer display device," as described and claimed by the Applicant.

Next, the Office Action again offers **Thorner** reference as describing the remaining features of the Applicant's claimed invention. However, as noted above, **Thorner** describes the capability to search through a plurality of databases to identify personal information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by **Thorner**. Therefore, when combined with the **Smiga** reference, the proposed combination simply produces a version of the **Smiga** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of "**scanning electronic data being rendered on the computer display device** to identify information within the electronic data that represents at least one person," as described above, it should be clear that the proposed **Smiga - Thorner** combination fails to teach or describe all of the elements of the Applicant's claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious

language of independent claim 24, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 24, and thus the rejection of dependent claims 25-27, 29 and 36 under 35 U.S.C. §103(a) over **Simga** in view of **Thorner**, in view of the non-obviousness of claim 24, as cited below:

“A computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person;

identifying each person represented by the identified information;

retrieving information relating to each identified person from at least one electronic database;

providing an alert for indicating that the retrieved information is available;

using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point.” (emphasis added)

2.3 Rejection of Claims 37-38, 40, 41 and 50:

Independent claim 37 was rejected under 35 U.S.C. §103(a) based on “grounds corresponding to the reasons given” for the rejection of claims 1, 4-6, 9, 11, 13, 14, and 20. Consequently, the discussion provided above with respect to the rejection of those claims also applies to the rejection of independent claim 37.

In particular, in the rejection of claims 1 and 24, the Office Action suggested that “the parser of Simga parses document, and ***identifies email addresses enclosed in the document***. The email address identifies a person.” (emphasis added)

However, the described above with respect to claim 1 and claim 24, Applicant again respectfully suggests that the Office Action has incorrectly interpreted the cited portions of the **Simga** reference. In particular, as noted above, **Simga** is simply parsing a document in order to find predefined "keywords," and then to return whatever information may have been associated with those keywords in some external database. Therefore, the Applicant respectfully suggests that in direct contrast to the position advanced by the Office Action, **Simga** fails to disclose the elements of claims 1 and 24, as described above.

Consequently, it should be clear that the **Simga** capability to find keywords via parsing of a **user entered text input** is **not** equivalent to parsing an electronic document to identify data representing any person, as described and claimed by the Applicant. In fact, **Simga** has no way of determining **what** the keyword represents beyond simply determining whether a predefined keyword **typed by the user** matches an entry in some external database, with that externally linked information then being returned to the user. While that externally linked information may be an email address in some cases, **Smiga** does not specifically identify email generic addresses enclosed in documents as suggested by the Office Action.

Further, it should be noted that as with claims 13 and 14, claim 37 includes an element directed towards **changing the appearance of the parsed document**. Specifically, claim 37 recites the following element: "**dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved**" (emphasis added). As noted above with respect to the rejection of claims 13 and 14, the Applicant believes that the Office Action incorrectly equates the Applicants electronic document, which is the actual document examined for the purpose of "**detecting any information in the electronic document that represents at least one person**" (emphasis added), with the **Smiga** "shadow region." As explained above, this shadow region represents a **separate display area** from the **user data entry region** on a display device which is used for displaying information retrieved in response to a keyword identification in the manually entered user text input. The separate display area

comprising the "shadow region" is **not** the actual electronic document itself, as described and claimed by the applicant. Therefore, **Smiga** does **not** disclose changing the appearance of the electronic document as disclosed and claimed by the Applicant.

In the rejection of claims 1 and 24, the Office Action offers the **Thorner** reference as describing the remaining features of the Applicant's claimed invention. However, as noted above, **Thorner** describes the capability to search through a plurality of databases to identify personal information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by **Thorner**. Therefore, when combined with the **Smiga** reference, the proposed combination simply produces a version of the **Smiga** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of "**detecting any information in the electronic document that represents at least one person,**" and "**dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved**" as described above, it should be clear that the proposed **Smiga - Thorner** combination fails to teach or describe all of the elements of the Applicant's claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 37, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 37, and thus the rejection of dependent claims 38, 40, 41 and 50 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner**, in view of the non-obviousness of claim 37, as cited below:

"A computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:

detecting any information in the electronic document that represents at least one person;

identifying each person based on a comparison of the detected information to data in at least one electronic database;

retrieving data related to each identified person from at least one electronic database;

dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved." (emphasis added)

2.4 Rejection of Claim 2:

Claim 2 was rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga - Thorner*** combination reference discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claim, i.e., claim 2 are obvious in further view of ***Srinivasan***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claim 2, the proposed ***Smiga - Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the proposed ***Smiga - Thorner*** combination reference, dependent claim 2 must also be patentable over the proposed ***Smiga - Thorner - Srinivasan*** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious

language of independent claim 1, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claim 2, and requests reconsideration of the rejection of claim 2 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner** in further view of **Srinivasan** in view of the non-obviousness of claim 1, as cited above.

2.5 Rejection of Claim 7, 8 and 39:

Claims 7, 8 and 39 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed **Smiga - Thorner** combination reference discloses the underlying parent claims, i.e., claim 1 and 37, respectively, and that the elements of the dependent claims, i.e., claim 7, 8, and 39 are obvious in further view of **Dimitrova**.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 7 and 8, and with respect to the rejection of independent claim 37, which is the parent claim of claim 39, the proposed **Smiga - Thorner** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1 and 37 have been shown to be patentable over the proposed **Smiga - Thorner** combination reference, dependent claims 7, 8, and 39 must also be patentable over the proposed **Smiga - Thorner - Dimitrova** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 7, 8, and 39, and requests reconsideration of the rejection of claims 7, 8, and 39 under 35 U.S.C. §103(a) over **Smiga**

in view of **Thorner** in further view of **Dimitrova** in view of the non-obviousness of claims 1 and 37, as cited above.

2.6 Rejection of Claims 10 and 12:

Claims 10 and 12 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed **Smiga - Thorner** combination reference discloses the underlying parent claim, i.e., claim 1 and that the elements of the dependent claims, i.e., claims 10 and 12, are obvious in further view of **Sorenson**.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 10 and 12, the proposed **Smiga - Thorner** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the proposed **Smiga - Thorner** combination reference, dependent claims 10 and 12 must also be patentable over the proposed **Smiga - Thorner - Sorenson** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 10 and 12, and requests reconsideration of the rejection of claims 10 and 12 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner** in further view of **Sorenson** in view of the non-obviousness of claim 1, as cited above.

2.7 Rejection of Claim 15, 28, 30 and 42-45:

Claims 15, 28, 30 and 42-45 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed **Smiga - Thorner** combination reference discloses the underlying parent claims, i.e., claims 1, 24 and 37, respectively, and that the elements of the dependent claims, i.e., claims 15, 28, 30 and 42-45 are obvious in further view of **Yamakita**.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claim 15, with respect to the rejection of independent claim 24, which is the parent claim of claims 28 and 30, and with respect to the rejection of independent claim 37, which is the parent claim of claims 42-45, the proposed **Smiga - Thorner** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1, 24 and 37 have been shown to be patentable over the proposed **Smiga - Thorner** combination reference, dependent claims 15, 28, 30 and 42-45 must also be patentable over the proposed **Smiga - Thorner - Yamakita** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, 24, and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 15, 28, 30 and 42-45, and requests reconsideration of the rejection of claims 15, 28, 30 and 42-45 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner** in further view of **Yamakita** in view of the non-obviousness of claims 1, 24, and 37, as cited above.

2.8 Rejection of Claim 16-19, 21-23, 31-34, and 46-49:

Claims 16-19, 21-23, 31-34, and 46-49 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed **Smiga - Thorner** combination reference discloses the underlying parent claims, i.e., claims 1, 24 and 37, respectively, and that the elements of the dependent claims, i.e., claims 16-19, 21-23, 31-34, and 46-49 are obvious in further view of **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 16-19 and 21-23, with respect to the rejection of independent claim 24, which is the parent claim of claims 31-34, and with respect to the rejection of independent claim 37, which is the parent claim of claims 46-49, the proposed **Smiga - Thorner** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1, 24 and 37 have been shown to be patentable over the proposed **Smiga - Thorner** combination reference, dependent claims 16-19, 21-23, 31-34, and 46-49 must also be patentable over the proposed **Smiga - Thorner - Appelman** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, 24, and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 16-19, 21-23, 31-34, and 46-49, and requests reconsideration of the rejection of claims 16-19, 21-23, 31-34, and 46-49 under 35 U.S.C. §103(a) over **Smiga** in view of **Thorner** in further view of **Appelman** in view of the non-obviousness of claims 1, 24, and 37, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that the finality of the rejection of claims 1-2 and 4-50 is premature, and must therefore be withdrawn. In addition, in view of the above, it is also respectfully submitted that claims 1-2 and 4-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-2 and 4-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



Mark A. Watson
Registration No. 41,370
Attorney for Applicant

Lyon & Harr
300 Esplanade Drive, Suite 800
Oxnard, California 93036
(805) 278-8855